

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of Docket No.: P26995
C. L. BATES, et al. Confirmation No.: 7213
Serial No.: 09/827,233 Group Art Unit: No. 2143
Filed: April 5, 2001 Examiner: D. E. England
For: **METHOD AND COMPUTER PROGRAM PRODUCT FOR PROVIDING
EMAIL THAT GUIDES A RECIPIENT THROUGH A SET OF ASSOCIATED WEB
PAGES**

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of February 27, 2007. Reconsideration and withdrawal of the 35 U.S.C. § 112, 2nd paragraph, the 35 U.S.C. § 102(e), and the 35 U.S.C. § 103(a) rejections are respectfully requested in view of the following remarks.

A prima facie case of indefiniteness has not been set forth and the Rejection Under 35 U.S.C. § 112, 2nd paragraph, Is Improper.

A prima facie case of anticipation has not been set forth and the Rejection Under 35 U.S.C. § 102(e) Is Improper.

A prima facie case of unpatentability has not been set forth and the Rejection Under 35 U.S.C. § 103(a) Is Improper

Examiner's Assertion

The Examiner asserts that claim 2 is indefinite because "it is unclear what is the association and/or relationship between the web page and the email", and clarifies in the Advisory Action that claim 2 is "very broad" and fails to explain how the navigation is associated with the email.

Applicants' Response

Applicants respectfully disagree. 35 U.S.C. § 112, 2nd paragraph, does not require that each recited feature of a claim have an association or relationship to another recited feature. Nor does

Section 112, 2nd paragraph require the claims to recite how something is associated. The specification provides this function (see, e.g., step 215 of Fig. 2 and paragraph [0021] of the instant published application 2002/0147779). Finally, Applicants submit that the Examiner not even cited any basis in patent law to support the Examiner's assertion of indefiniteness.

Examiner's Assertion

In support of the 35 U.S.C. § 102(e) rejection over CARTER, the Examiner explains that the preferred viewing order is taught at col. 3, lines 17-41 and at col. 4, line 45 to col. 5, line 26.

Applicants' Response

Applicants respectfully disagree. Applicants herein incorporate the arguments on pages 10-13 of the Rule 1.116 Response, and note the noted language merely discloses how a sender can select web pages so that a URL can be attached to an email for sending. This is not the same as sending and/or receiving an email including a web page navigation having any viewing order, much less, a preferred viewing order defined by the originator.

Examiner's Assertion

In the Advisory Action, the Examiner explains that CARTER also teaches the recited preferred viewing order because it discusses how an email originator can select files and place them in an attachment (which can broadly be construed as a preferred viewing order), and cites the language of col. 7, lines 37 et seq. and col. 12, line 40 to col. 13, line 34.

Applicants' Response

Applicants respectfully disagree. It is true that the noted language of CARTER discloses how a sender can select web pages so that a URL can be attached to an email for sending. However, CARTER does not even remotely discuss generating a web page navigation that includes a plurality of uniform resource locators and a preferred viewing order, associating the navigation with the email, and sending the email and the navigation to the recipient (claims 1 and 9). Attaching URLs to an email is simply not the same as, e.g., associating a navigation which includes URLs with the email.

Furthermore, as CARTER does not discuss the details of what happens after the email is sent to a recipient, it cannot possibly disclose receiving a web page navigation associated with the email, much less, passing the web page navigation to a web browser, and displaying by the web browser a preferred viewing order in which web pages identified by the web page navigation are to be viewed (claims 2 and 10) and/or sending the email and the web page navigation to the recipient, much less,

passing the web page navigation to a web browser used by the recipient, and displaying by the web browser an indication of the preferred viewing order (claims 3 and 11).

Examiner's Assertion

The Examiner insists that CARTER does in fact teach associating a navigation with the email and/or sending or receiving the email and the navigation (claims 1-3 and 9-11).

Applicants' Response

Applicants respectfully disagree. The Examiner is simply not correct. CARTER is silent with regard to associating a navigation with the email and/or sending or receiving the email and the navigation. Again, while it is true that CARTER discloses that the sender can attach URLs to an e-mail after the sender navigates through a list of files or HTML documents for attachment to the e-mail (see col. 3, lines 17-41) and that this can be accomplished using a graphical user interface (GUI) (see col. 5, lines 12-22), CARTER does not disclose that the files which can be attached to the e-mail can be a navigation which is used by the receiver. The "GUI" of CARTER, which the Examiner identifies as being able to allow the receiver to view a viewing order of files, is only disclosed in CARTER as being usable by the sender and not the receiver of an e-mail.

Nor does the language cited by the Examiner in CARTER support the Examiner's position to the contrary. Col. 3, lines 23-27 of CARTER merely explains:

When the receiver reads the message, there is an indicator that one or more files are attached. The receiver activates the attach button and is presented with a dialogue box that enables the receiver to retrieve the attached file or files and place them somewhere in the receiver's file system (emphasis added).

Retrieving a file attached to an e-mail is simply not the same as receiving a navigation attached to an e-mail, much less, a navigation including URLs in a preferred viewing order.

Examiner's Assertion

The Examiner also asserts that CARTER teaches that an e-mail sent with a navigation can be passed to a web browser of the receiver of the e-mail (claims 2, 3 and 10).

Applicants' Response

Applicants respectfully disagree. The Examiner has failed to point to any language whatsoever in CARTER which even remotely discloses that an e-mail sent with a navigation can be passed to a web browser of the receiver of the e-mail (claims 2, 3 and 10).

Examiner's Assertion

In support of the 35 U.S.C. § 103(a) rejection based on CARTER and BATES, the Examiner acknowledges that CARTER lacks the recited preferred viewing order with link colors, icons, and font characteristics, but explains that such features are taught by BATES.

Applicants' Response

Applicants respectfully disagree. BATES does not cure the noted deficiencies of CARTER. BATES, for example, is entirely silent with regard to email includes a preferred viewing order as recited in claims 3, 8, 11 and 16. Indeed, while the Examiner has asserted that BATES teaches a browser program having a preference file 244 for navigation web links, the Examiner has failed to point to any language in BATES which discloses or suggests that an email can include a navigation having URLs in a preferred viewing order as recited in claims 3, 8, 11 and 16.

Furthermore, as the Examiner will note, the above-noted claims recite, among other things, the sending of an email and a navigation which includes a preferred viewing order. On the other hand, BATES fails to disclose or suggest a preferred viewing order, much less, the sending of an email which includes, among other things, a navigation having URLs in a preferred viewing order.

Applicants note, in particular, that while the system in BATES provides for sending an email with browser information, col. 9, lines 54-59 of BATES explains the following:

The browser information contained in the e-mail message may then be utilized to configure a browser program located on the remote client computer. One embodiment illustrating a method 800 for receiving and applying browser information by a receiving client computer is shown in FIG. 8.

Thus, BATES discloses a system which allows a user to send an email with browser information which will configure the browser of the recipient. However, this is not the same as sending an email along with a navigation that includes URLs in a preferred viewing order.

As no proper combination of BATES and CARTER discloses or suggests the above-noted features of independent claims 3, 8 and 11, no proper combination of these documents can properly disclose or suggest the features of claims 4, 6, 12 and 14 which respectively depend from these claims, and which further recite features which are not disclosed or suggested by any proper combination of BATES and CARTER.

Applicants remind the Examiner that in establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, it is incumbent upon the Examiner to provide a reason *why* one of ordinary skill in (P26995 00186918.DOC)

the art would have found it obvious to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. *See Ex parte Clapp*, 227 USPQ 972 (B.P.A.I. 1985).

Applicants also note that BATES is prior art only under 35 UCS 102(e), and that this rejection is improper under 35 UCS 103(c) because BATES and the instant application were commonly owned by IBM at the time the instant application was filed. Accordingly, Applicants reserve the right to make this assertion should the Examiner not withdraw this rejection.

Finally, to the extent that the Examiner is basing the instant rejection on an argument of inherency consistent with MPEP 2112, Applicants note that MPEP 2112 specifically states, in part:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

The Examiner has neither stated that the rejection is based on inherency, nor provided any basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

CONCLUSION

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
C. L. BATES, et al.


Andrew M. Calderon
Registration No. 38,093

May 11, 2007
Greenblum & Bernstein, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191
Telephone: 703-716-1191
Facsimile: 703-716-1180
{P26995 00186918.DOC}